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Supreme Court, U.S.
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No. 01-240

IN THE

Supreme Court of the United States

ROBOTIC VISION SYSTEMS, INC.,

Petitioner,

v.

VIEW ENGINEERING, INC. and
GENERAL SCANNING, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

Petitioner's Rule 29.6 Statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

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REPLY TO BRIEF IN OPPOSITION

Petitioner Robotic Vision Systems, Inc. ("RVSI") seeks a writ of certiorari because the decision below interprets this Court's holding in *Pfaff v. Wells Electronics*, 525 U.S. 55 (1998), in a manner that eliminates the constitutional and statutory requirement of utility as a condition for patentability, and holds that an invention that is not yet known to work for its intended purpose can be deemed "ready for patenting." Petitioner further seeks review of the decision below because that decision totally ignores development work after an offer for sale and, in effect, eliminates the second part of the test articulated in *Pfaff*, which requires, prior to the critical date, either a reduction to practice or "drawings or other descriptions" sufficiently specific to enable a person skilled in the art to practice the invention.

In its Brief in Opposition, View misstates the facts and miscasts RVSI's positions in order to obfuscate the real issues and escape any substantive review of the Federal Circuit's departure from the *Pfaff* test. View's tactic is to regale this Court with irrelevant or inaccurate "facts," and to restate the question presented as "[w]hether one co-inventor's *uncorroborated testimony* that he did not know whether his invention would be *commercially feasible*, alone, prevents a court from finding the invention is ready for patenting." (Br. in Opp. at i) (emphasis added). Contrary to View's assertions, the testimony of the co-inventor was neither uncorroborated nor about the commercial feasibility of the invention. View's diversionary tactics cannot mask the lower courts' apparent confusion regarding the application of the newly promulgated on-sale bar test, both at the district court[1] and the Federal Circuit levels,[2] and the Federal

1. As set forth in RVSI's opening brief, there is confusion among the lower courts regarding whether conception alone can satisfy the "ready for patenting" test. *See* RVSI Pet. for Cert. at 3 n.5, 12-15.

2. There is a split among different panels of the Federal Circuit regarding whether inventor confidence is a factor in the "drawings or (Cont'd)

Circuit's impermissible expansion of that test in this particular case.

I. The Decision Below Conflicts With the Utility Requirement

The statutory utility requirement is satisfied when an inventor has learned enough about a product to justify the conclusion that it is useful for a specific purpose. *See, e.g., Estee Lauder, Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 593 (Fed. Cir. 1997). The Federal Circuit completely disregarded this requirement when it found that the invention described in the '227 Patent was "ready for patenting" prior to the critical date, despite the fact that the inventors did not know whether the invention would be useful. According to the Federal Circuit, inventor skepticism is only relevant to a determination of whether an invention is ready for patenting under the "reduction to practice" prong of the test, and need not be considered at all under the "drawings or other descriptions" prong. Pet. App. 9a ("Notably absent from this test is a requirement that an inventor have complete confidence that his invention will work for its intended purpose. Such confidence often must await a reduction to practice, which is a separate basis on which an invention may be shown to be ready for patenting.")

(Cont'd)

other descriptions" prong of the "ready for patenting" test. *Compare Robotic Vision Sys., Inc. v. View Eng'g, Inc.*, 249 F.3d 1307 (Fed. Cir. 2001) (inventor confidence is only applicable to the reduction to practice prong of the ready for patenting test) (*see* Pet. App. 9a) *with Weatherchem Corp. v. J.L. Clark, Inc.*, 163 F.3d 1326, 1333-34 (Fed. Cir. 1998) (considering inventor testimony regarding the workability of his invention in connection with the "drawings or other descriptions" prong of the "ready for patenting" test) *and STX, LLC v. Brine, Inc.*, 212 F.3d 588, 591 (Fed. Cir. 2000) (considering inventor confidence that the invention was complete and operative in the ready for patenting analysis).

A. View's Misrepresentations About the Skepticism of the Inventors Is an Obvious Ploy to Divert Attention from the Real Issues, All of Which Warrant Certiorari

Throughout its Brief, View repeatedly characterizes the testimony of one of the inventors, Mr. Howard Stern, as both "uncorroborated" and "interested." View's statements that the inventor's testimony was uncorroborated are not only untrue,[3] but also irrelevant because the Federal Circuit expressly declined to address the skepticism of the inventors *at all* in its "ready for patenting" analysis, deeming that factor only applicable to the reduction to practice prong of the test.

The issue before this Court is not whether the inventor's testimony was corroborated or whether the Federal Circuit properly weighed the evidence of inventor skepticism. Rather, the real issue is whether the Federal Circuit misinterpreted this Court's decision by assuming that *Pfaff* directed courts to disregard evidence of utility altogether in connection with the "drawings or other descriptions" prong of the test. As set forth in RVSI's opening brief, evidence of skepticism is probative of whether the invention was known to have utility and whether it is even possible for the invention to have been enabled prior to the critical date. As such, it is critical to a "ready for patenting" analysis, which necessarily entails a determination of whether all the requirements for patentability could have been met at the time in question. Thus, the Federal Circuit's assertion that *Pfaff* prohibits consideration of this factor in the on-sale bar's "drawings or other descriptions" analysis cannot be correct. Because the application of *Pfaff* already has caused confusion

3. View totally ignores the testimony of Mr. Bilodeau, and his written note to the CEO of the company, Mr. Pat Costa, which was written no earlier than two days prior to the critical date. In that note, which corroborates Mr. Stern's testimony, Mr. Bilodeau informed Mr. Costa that RVSI had no way of making the column and row method work. A6135.

in the lower courts, including a split among different panels of the Federal Circuit on this particular issue,[4] it warrants this Court's immediate review.

B. The Federal Circuit's Assumption that *Pfaff* Bars Any Consideration of the Utility Requirement In the "Drawings or Other Descriptions" Prong of the "Ready For Patenting" Analysis Cannot Be Left Uncorrected

View does not dispute that the *Pfaff* Court intended to trigger the on-sale bar from the moment that a patentee could have obtained a patent. View also does not dispute that inventors have been able to obtain a patent for their inventions as long as the three requirements for patentability — utility, novelty, and non-obviousness — are met, and the patent application meets the requirements of § 112, including the enablement requirement. If the foregoing requirements are met, inventors can obtain a patent regardless of whether the invention was actually reduced to practice. *The Telephone Cases*, 126 U.S. 1 (1888) (upholding a patent issued to Alexander Graham Bell even though he filed his application before constructing a working telephone).

In *Pfaff*, this Court specifically referenced *The Telephone Cases* to explain that a physical embodiment of an invention is not required for patentability. The Court went on to hold that an invention can be "on sale" as long as it is "ready for patenting." Nowhere in its decision, however, did the Court indicate that inventor skepticism was to be thereafter disregarded in the "drawings or other descriptions" prong of the "ready for patenting" analysis. Petitioner submits that the Court made no such holding, and that such an interpretation of *Pfaff* would place it in direct conflict with other provisions of the Patent Act and prior decisions of this Court, as set forth in RVSI's opening brief.

4. *See* note 2, *supra*, and cases cited therein.

In addition, Petitioner submits that the decision below conflicts with at least one decision of another circuit court. Specifically, the First Circuit has invalidated a patent for lack of utility based on evidence of inventor skepticism regarding whether the invention will work as intended in its contemplated use. *See, e.g., Gross v. General Motors Corp.*, 521 F.2d 45, 49 (1st Cir. 1975). The First Circuit's decision cannot be reconciled with the Federal Circuit's position that an invention can be "ready for patenting" even if the inventors are uncertain as to whether the invention will work for its intended purpose. Simple logic dictates that the "ready for patenting" test for invalidating a patent under the on-sale bar cannot be more lax than the conditions for patentability, including utility.

View has not responded to this issue, but instead asserts that *Pfaff* does not require freedom from all skepticism. For this proposition, View cites *The Telephone Cases* and argues that if the telephone did not need to be reduced to practice to remove skepticism regarding its workability, then RVSI's invention did not need to be reduced to practice either to be "ready for patenting," and therefore "on sale." View misses the point. *The Telephone Cases* merely stands for the proposition that a physical embodiment of the invention is not required for patentability. In that case, there was no issue of inventor confidence. Significantly, neither *Pfaff* nor *The Telephone Cases* deal with a situation where, as here, corroborated and objective evidence alone demonstrates that inventor confidence is lacking.

The confusion on this issue, and the misreading of this Court's *Pfaff* decision, apparently stems from the fact that "reduction to practice," a term of art, refers to more than just the construction of a physical embodiment of an invention, but also entails proof that the invention be known to work for its intended purpose. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1563 (Fed. Cir. 1996) (reduction to practice cannot be established without a showing of utility). This latter aspect of the reduction

to practice analysis is very similar to the requirements for utility under 35 U.S.C. § 101. *See* RVSI Pet. for Cert. at 15-16 n.16-17, and cases cited therein. As a matter of fact, the utility requirement has long been subsumed within the reduction to practice analysis because of the similarities. *Id.*[5] Petitioner submits that this particular aspect of reduction to practice was not at issue in *Pfaff* or *The Telephone Cases*, and has not been discarded by this Court's holding that an actual physical embodiment of an invention is not required for an invention to be "ready for patenting."

C. View's Assertions that the Invention Had Utility At Conception Lack Merit And Cannot Preclude Certiorari

Failing to address any of the relevant issues, View instead recasts RVSI's position and misstates facts in order to hide the enormity of the Federal Circuit's expansion of the *Pfaff* decision. View asserts that RVSI knew at conception that the invention had utility — which View conveniently characterizes as

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5. The Federal Circuit itself has recognized that reduction to practice and utility are intertwined. Citing this Court's decision in *Brenner v. Manson*, 383 U.S. 519 (1966), and prior Federal Circuit cases, the Federal Circuit in *Fujikawa* stated:

> For over 200 years, the concept of utility has occupied a central role in our patent system. Indeed, "[t]he basic *quid pro quo* contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility." Consequently, it is well established that a patent may not be granted to an invention unless substantial or practical utility for the invention has been discovered or disclosed. Similarly, actual reduction to practice, which constitutes in law the final phase of invention, cannot be established absent a showing of practical utility.

93 F.3d at 1563 (citations omitted).

inspecting integrated circuit chips. View's recitation of the intended function for all integrated circuit chip inspection machines, however, does not demonstrate that the inventors knew that their concept of an improved method of performing inspections would actually work to accurately perform such inspections. Obviously, if an inspection machine uses a method that is unable to collect accurate data from the semiconductor chips, any contemplated utility for such a method is defeated. *See, e.g., Estee Lauder*, 129 F.3d at 593. Here, because the inventors did not and could not know at conception whether their new inspection method would produce accurate results, they could not have known whether their invention had any utility. View's unfounded and unsupported assertion that the invention had utility at conception is simply untenable.[6]

Moreover, the object of the invention described in the '227 Patent was not to merely inspect integrated circuit devices, but to do so more quickly than prior art methods. The Federal Circuit recognized this objective. Pet. App. 28a, 39a. Thus, View's argument that an invention need not meet all of the inventor's objectives, and need not be the best way to accomplish an inventor's objectives in order to satisfy the utility requirement is inapplicable to the present situation, where the inventors did

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6. On this point, View utterly disregards the testimony of the inventors and other RVSI personnel working on the column and row project. That testimony demonstrates that the column and row method was not known to work for its intended purpose at conception because the inventors recognized that changing the scan path would lead to increased sensitivity to vibration and movement of the trays and/or the chips. It was not known to the inventors at conception, or the other engineers who subsequently worked on the project, whether the column and row method could be used to accurately scan and inspect devices or whether the increased sensitivity to vibration and movement induced by a faster moving column and row scan would prevent collection of accurate data for inspection purposes. Other objective evidence demonstrates that the skepticism continued up to and beyond the critical date. A6135.

not know if *any* of the contemplated objectives could be accomplished.

II. The Decision Below Conflicts with the Enablement Requirement

As it did with the utility argument, View fails to address RVSI's enablement argument: that RVSI could not have met the enablement requirement prior to the critical date because RVSI was still developing the invention at that time. View incorrectly argues that there is no evidence of any development, and further argues that RVSI did not tie the development work to the patent disclosure and the claimed invention. View's assertion is surprising, given that the connection between the development work and the patent disclosure is set forth on page 5 and page 16, footnote 27, of RVSI's opening brief. View's assertion is also puzzling because the Federal Circuit has squarely addressed the enablement issue for the '227 Patent, and its connection to the disclosure in the patent specification:

> *The functions that a software program would instruct the computer to perform for controlling the machine are readily apparent from the specification of the patent at issue here, which describes the scan paths and parameters for full tray scanning.* View has not presented any evidence to controvert Robotic's assertion that *one skilled in the art could generate the necessary software program to implement the disclosed functions.*

Pet. App. 34a (emphasis added). Thus, the invention could not have been enabled until all of the information described in the specification, which was derived from the development work, was determined and could be disclosed in a patent specification.[7]

7. View attempts to further discredit RVSI witnesses by asserting that the other co-inventor, Mr. Yonescu, did not share Mr. Stern's (Cont'd)

At the time of Mr. Yonescu's instruction to Mr. Briceno to begin writing the software, no such detailed explanation and description was given or even available.

As explained in RVSI's opening brief, holding that an invention is ready for patenting in such circumstances would essentially mean that conception alone is sufficient to meet the "ready for patenting" test.[8] It is, after all, undisputed that no work was done on the invention from conception until after Mr. Yonescu's instruction to Mr. Briceno. Under such an analysis, mere conception would be sufficient to render an invention "ready for patenting" for invalidity purposes, yet insufficient to obtain a patent from the U.S. Patent and Trademark Office. Surely such an anomaly was not intended by this Court when it rendered its *Pfaff* decision. This Court should grant a writ of certiorari in order to clarify its decision and prevent further confusion among the lower courts on this issue.

III. View's "Subjective Test" Arguments Are Unfounded

View also miscasts RVSI's position as a "subjective application" of the ready for patenting test, only to set up an argument that such a subjective application would eviscerate the test and eliminate the on-sale bar as a defense. View's argument is again premised on misstatements and

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skepticism (without any citation to the record) because in the first appeal he had stated that the software to implement the invention was within the skill in the art. In that appeal, the Federal Circuit rejected View's distortion of Mr. Yonescu's declaration, and understood that Mr. Yonescu's declaration stated that one of ordinary skill in the art could generate the necessary software to implement the invention given the full disclosure in the patent application. Pet. App. 33a-34a.

8. The confusion surrounding the issue of whether conception alone suffices to meet the "ready for patenting" test is set forth in RVSI's opening brief. *See* note 1, *supra*.

mischaracterizations. RVSI did not and does not advocate a subjective "ready for patenting" test. RVSI merely noted that commentators agree that an inventor's knowledge regarding the workability of his invention is relevant to the on-sale bar's "ready for patenting" analysis, but disagree as to whether this requirement should be objective or subjective. In fact, RVSI argued that based on *objective evidence alone* it was apparent that the invention described in the '227 Patent was not ready for patenting prior to the critical date.

It has never been Petitioner's position to base a "ready for patenting" conclusion on an inventor's uncorroborated subjective testimony. Such a test would be no better than the Respondents' proposed test that would invalidate a patent, which is presumed to be valid, based solely on an instruction to begin a project from a supervisor to an employee in the hallway of a research and development laboratory. RVSI never advocated that uncorroborated inventor skepticism, alone, be dispositive. Rather, RVSI argued that inventor testimony and objective, corroborated evidence of inventor skepticism must be considered in the "ready for patenting" analysis. Here, it was not, purportedly because of this Court's decision in *Pfaff*.

CONCLUSION

The Court should grant certiorari to clarify its "ready for patenting" test in complex cases using, for instance, software technology as in this case, so as to prevent further confusion and erroneous applications of its test. Accordingly, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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